

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-0358

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19 and 21-22 are currently pending. Claim 20 is hereby canceled, without prejudice or disclaimer of subject matter. Claims 1, 3, 4, 5, 10, 13, 16, 21 and 22 are independent. Claims 1, 3, 4, 5, 10, 13, 16, 21 and 22 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed, and specifically at pages 47-54 and Figures 17, 18, and 23.

Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4, 9 and 16-22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely "Franco") in view of U.S. Patent Application Publication No. 2001/0029610 to Corvin et al. (hereinafter, merely "Corvin").

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-0:358

Claims 5-8 and 10-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco in view of Corvin and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely "Ozer").

As understood by Applicants, Franco relates to a remotely programmable broadcast content recording system that is programmed through a web page to record broadcast content such as television programs.

As understood by Applicants, Corvin relates to systems and methods for providing promotions with recorded programs. These systems and methods provide for selecting a program to record, selecting a promotion, recording the selected program; and recording the promotion with the program or inserting the promotion during playback of the recorded program.

As understood by Applicants, Ozer relates to systems and methods for providing; and tracking viewing behavior of home entertainment systems.

A. INDEPENDENT CLAIMS 1, 3, AND 4

Claim 1 recites, *inter alia*:

"... display control means for controlling the displaying of said advertisement-associated data received by said receiving means to display said advertisement-associated data and said television program substantially at same time for a viewer to view said advertisement-associated data while simultaneously viewing said television program." (Emphasis added)

Applicants respectfully submit that the combination of Franco and Corvin does not disclose or suggest, displaying the advertisement-associated data and the television program substantially at same time for a viewer to view the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1.

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-0358

Indeed, Applicants respectfully submit that both Franco and Corvin teach away from displaying the advertisement-associated data and the television program at the same time, so that a user views simultaneously the advertisement-associated data and the television program. Franco teaches on page 12, paragraph [0133], that “viewers can avoid watching commercials that are not of interest,” which clearly teaches away from a viewer viewing the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. Corvin teaches on page 3, paragraph [0032], that:

“the insertion of a selected promotion during playback of the recorded program may cause the processor to send, for example, a pause or stop command or signal to halt the playback of the recorded program. After, the promotion is inserted and played, the processor may then send a command or signal to continue the playback of the remaining portion or portions of the recorded program.” (Emphasis added)

Thus, Corvin clearly teaches away from displaying the advertisement-associated data and the television program at the same time, as recited in claim 1.

Applicants respectfully submit that Ozer does not teach or suggest the disclosure missing from Franco and Corvin.

Therefore, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1, independent claims 3 and 4 are also believed to be patentable.

B. INDEPENDENT CLAIMS 5, 10, AND 13

Claim 5 recites, *inter alia*:

“... display control means for controlling the displaying of said advertisement-associated data received by said first receiving means to display said advertisement-associated data for a viewer”

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-0358

to view said advertisement-associated data before receiving
said preset- recording data by said second receiving means,

wherein said viewer cannot view said television program unless
said advertisement-associated data first has been displayed."
(Emphasis added)

Claim 5 provides that the second receiving means **cannot** receive the preset-
recording data until and unless the first receiving means has received the advertisement-
associated data, the display control means has displayed the advertisement-associated data, and
the notification means has notified the information providing apparatus that a predetermined
condition is satisfied. That is, claim 5 provides for an apparatus that **cannot** display a television
program until and unless the advertisement has been displayed.

Applicants respectfully submit that the combination of Franco and Corvin does
not disclose or suggest, displaying the advertisement-associated data for a viewer to view the
advertisement-associated data before receiving said preset- recording data by the second
receiving means, so that the viewer cannot view the television program unless the viewer has
viewed the advertisement-associated data, as recited in claim 5.

Indeed, as explained in detail above in response to the rejection of claim 1, both
Franco and Corvin teach away from the feature recited in claim 5. Franco discloses that viewers
can avoid watching commercials, and thus teaches away from the viewer having to view the
advertisement before being able to view the television program. Corvin discloses that the
promotion is inserted somewhere into the program, but does not prevent a viewer from skipping
the commercial, the feature recited in claim 5.

Applicants respectfully submit that Ozer does not teach or suggest the disclosure
missing from Franco and Corvin.

Therefore, Applicants respectfully submit that claim 5 is patentable.

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-03358

For reasons similar to those described above with regard to independent claim 5, independent claims 10 and 13 are also believed to be patentable.

C. INDEPENDENT CLAIMS 16, 21, AND 22

Claim 16 recites, *inter alia*:

“... first transmitting means for transmitting said advertisement-associated data acquired by said acquiring means to said information processing apparatus; and

second transmitting means for transmitting said preset-recording data generated by said generating means to said information processing apparatus after said advertisement-associated data has been displayed on said information processing apparatus.”
(Emphasis added)

Applicants respectfully submit that the combination of Franco and Corvin does not disclose or suggest, transmitting the preset-recording data to the information processing apparatus after the advertisement-associated data has been displayed on the information processing apparatus, as recited in claim 16.

Indeed, as explained in detail above in response to the rejection of claim 1, both Franco and Corvin teach away from the feature recited in claim 16. Franco discloses that viewers can avoid watching commercials, and thus teaches away from the viewer having to view the advertisement before being able to view the television program. Corvin discloses that the promotion is inserted somewhere into the program, but does not prevent a viewer from skipping the commercial, the feature recited in claim 16.

Applicants respectfully submit that Ozer does not teach or suggest the disclosure missing from Franco and Corvin.

Therefore, Applicants respectfully submit that claim 16 is patentable.

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-03358

For reasons similar to those described above with regard to independent claim 16, independent claims 21 and 22 are also believed to be patentable.

III. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

U.S. Application No. 09/911,911
Reply to Office Action dated July 28, 2005

PATENT
450100-03358

CONCLUSION

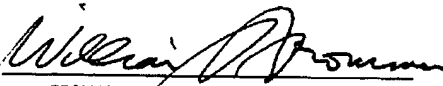
All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By 
William S. Frommer
Reg. No. 25,506
(212) 588-0800